

REMARKS

Claims 1-30 are pending in the application.

Claims 1-30 have been rejected.

Reconsideration of the claims is respectfully requested.

The Examiner is thanked for noting the typographic error in some reference numbers of Figure 1. Applicant hereby submits replacement drawings, and the objection is believed obviated.

I. CLAIM REJECTIONS -- 35 U.S.C. § 112

Claims 1-8, 11-18 and 21-30 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is respectfully traversed.

There are two separate requirements under 35 U.S.C. §112, second paragraph. MPEP §2171, p. 2100-209 (8th ed., rev. 5, August 2006). The first is subjective and requires that the claims must set forth the subject matter that the Applicants regard as their invention. *Id.* The second is objective and requires that the claims must particularly point out and distinctively define the metes and bounds of the subject matter that will be protected by the patent grant (*i.e.*, whether the scope of the claim is clear to one of ordinary skill in the art). *Id.* at 2100-210. The Examiner should explain whether the rejection is based on indefiniteness or on the failure to claim what the Applicants regard as their invention. *Id.* (*citing Ex parte Ionescu*, 222 U.S.P.Q. 537, 539 (Bd. App. 1984)).

The Examiner rejects these claims, asserting that they are indefinite for failing to “point out and distinctly claim the subject matter which applicant regards as the invention.” This rejection is based on a misreading or mistaken analysis of the claim language. The Examiner

states, without basis, that “the measured distance depends up the angle taken to traverse the body.” The Examiner appears to believe that the claim requires measuring a vector at some random angle between the walls. It does not; the claim requires measuring a distance between a first element and a second element, and storing a wall thickness corresponding to the measured distance. This is clearly described in the specification, and clearly and definitely described in the claims.

Claim 1 reflects what the Applicants regard as the invention. The Examiner’s rejection appears to be a complaint that the process claimed – as misinterpreted by the Examiner – may not result in what the Examiner believes to be an optimal result.

Independent claims 1, 11, and 21 each clearly describe what the Applicants regard as the invention; including identifying a first element, traversing the internal body topology to identify a second element, measuring the distance between the first element and the second element, and storing a wall thickness corresponding to the measured distance. Dependent claims describe different techniques for traversing the body and identifying the second element, but does not change the “measuring” aspect, which measures the distance between the first and second elements, however identified, as does not rely at all on the “angle taken” as alleged by the Examiner, as the measured distance between the two elements is constant once the second element has been identified.

As the statute only requires that the claims describe what the Applicants regard as the invention, and the rejection is based on a misinterpretation of the claims by the Examiner, the Applicants respectfully request the Examiner to withdraw the § 112 rejections.

The Examiner rejects claims 21 and 29 for having no literal support for “machine-readable medium” in the specification. Of course, the law is clear that such literal support is not required.

Adequate description under the first paragraph of 35 U.S.C. 112 does not require literal support for the claimed invention. *In re Herschler*, 591 F.2d 693, 200 USPQ 711 (CCPA 1979); *In re Edwards*, 568 F.2d 1349, 196 USPQ 465 (CCPA 1978); *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976). Rather, it is sufficient if the originally-filed disclosure would have conveyed to one having ordinary skill in the art that an appellant had possession of the concept of what is claimed. *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973).

One of skill in the art would clearly understand that instructions in a machine-useable medium are necessarily machine-readable, as claimed. Nevertheless, in an attempt to accommodate the Examiner, claims 21 and 29 are amended to specify a “machine useable medium”.

All these rejections are traversed, and the Applicants respectfully request the Examiner to withdraw the § 112 rejections

II. Claim Rejections Under 35 U.S.C. § 101

Claims 9, 10 and 19-30 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. This rejection is respectfully traversed.

No rejection is stated as to claim 10, and this reference by the Examiner is assumed to be a typographic error.

Claims 9, 19, and 29 are amended to indicate that the determined distance is stored. This is believed to obviate the Examiner’s “useful” and “tangible” concerns.

With regard to claims 21 and 29, the specification is amended above to remove reference to transmission-type or signal-bearing mediums, although no court has yet ruled that this is not

the statutory subject matter that it has long been held to be, despite the USPTO removing any reference to this in the current MPEP.

With regard to the Examiner's comment that "software per se" is not patentable, Applicants can only respectfully note that this is simply not true under current U.S. law. While the European Patent Office and some other countries have a specific prohibition on "software per se", the United States has no such prohibition. MPEP 2106.01 clearly states that "[w]hen a computer program is recited in conjunction with a physical structure, such as a computer memory, USPTO personnel should treat the claim as a product claim." As these claims recite a computer program product having instructions stored in a machine usable medium, they are to be considered as a statutory product claim.

Applicants also note that the un-amended form of these claims, a "computer program product tangibly embodied" in the machine readable medium has specifically been found to be statutory subject matter, and in fact this language appears in the claims of a multitude of issued patents.

All statutory subject matter rejections are obviated or traversed, and reconsideration and allowance are respectfully requested.

CONCLUSION

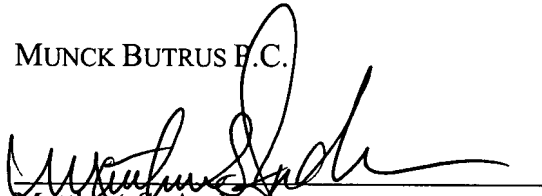
As a result of the foregoing, the Applicants assert that the remaining Claims in the Application are in condition for allowance, and respectfully request an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *manderson@munckbutrus.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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